

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY E. HUNDLEY and DANIEL H. URECHE

Appeal No. 1999-1494
Application 08/596,062

ON BRIEF¹

Before ABRAMS, McQUADE and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Larry E. Hundley et al. appeal from the final rejection of claims 1 through 9. Claim 10, the only other claim pending in the application, stands withdrawn from consideration pursuant to 37 CFR § 1.142(b). We reverse and remand for

¹ Inasmuch as the appellants failed to attend the oral hearing scheduled for January 27, 2000 (see Paper No. 17), this appeal has been decided on brief.

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further consideration.

The subject matter on appeal relates to "a two-piece cable tie of the type having a metal locking wedge inserted into a strap accepting channel formed through a strap locking head which acts as a strap locking mechanism" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A cable tie including a strap having a first end and a free end, a locking head secured to the first end of the strap, a plurality of walls on the locking head forming a strap accepting channel, and a metal locking wedge having a strap engaging portion positioned within the strap accepting channel and an embedded portion mounted within an inner wall of the locking head and a flexure region disposed therebetween, comprising:

a groove formed on the embedded portion of the metal locking wedge.

The references relied upon by the examiner in support of the appealed rejections are:

Reynolds	3,408,699	Nov. 5, 1968
Bernard et al. (Bernard)	5,517,727	May 21, 1996
Woods, European Patent Document 0 662 429		Jul. 12, 1995

Claims 1 through 9 stand rejected under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 1 through 10 of the Reynolds patent.

Claims 1, 2, 4 through 7 and 9 also stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 16 of the Bernard patent in view of Woods.

Reference is made to the appellants' main and reply briefs (Paper Nos. 11 and 13) and to the examiner's answer (Paper No. 12) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

In arguing the first rejection, the appellants submit that

the owner of expired [P]atent No. 3,408,699 to Reynolds is not and never has been the assignee of the current application, Panduit Corp. Nor is there any common inventorship between Reynolds '699 and the present invention. Therefore, since there is no common relationship of inventorship and/or ownership, there should be no consideration given to the issue of double patenting (see MPEP §804 Definition of Double Patenting) [main brief, page 3; reply brief, page 4].

The examiner has not challenged the asserted lack of common relationship of inventorship and/or ownership. Instead, the examiner, relying on the provisions of 35 U.S.C.

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§ 101, contends that "it is not necessary to show common relationship of inventorship and/or ownership in order to employ U.S. Patent No. 3,408,699 in the double patenting rejection" (answer, page 5).

The examiner, however, has failed to advance any authority or cogent explanation for this apparently novel interpretation of 35 U.S.C. § 101. As alluded to by the appellants, section 804 of the Manual of Patent Examining Procedure states that "[b]efore consideration can be given to the issue of double patenting,

there must be some common relationship of inventorship and/or ownership of two or more patents or applications." Since the record before us indicates a lack of common relationship of inventorship and/or ownership between the instant application and the Reynolds patent, the examiner's concern that the two raise a double patenting problem is unfounded.

Accordingly, we shall not sustain the standing obviousness-type double patenting rejection of claims 1 through 9 which is predicated on the Reynolds patent.

In contrast to the foregoing situation, there is no dispute that the instant application and the Bernard patent are commonly owned. With regard to the second double patenting rejection on appeal, the examiner explains that

[t]he patented and the pending claims set forth the same invention of substantially the same scope except the invention of patented claims 1-16 lacks a groove formed on an embedded portion of a metal locking wedge. However, it is well known in the art [as demonstrated by Woods] to employ a groove (30,31) on an embedded portion of barb (25) in order to produce a section of reduced barb width and to reduce the weakening of the flexure region.

In view of Woods, it would have been obvious to one of ordinary skill in the art to modify the patented metal locking wedge of claims 1-16 by forming a groove on the metal locking wedge in order to produce a section of reduced barb width and to reduce the weakening of the flexure region [answer, page 4].

The examiner's analysis here is flawed because it fails to account for a substantial difference between the appellants' claims and the claims in the Bernard patent. The question in an obviousness-type double patenting analysis is whether any claim in an application defines merely an obvious variation of an invention disclosed and claimed in a patent. See In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA

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1970). Each of the claims in the Bernard patent recites a cable tie comprising, inter alia, a pocket or pocket means in the locking head of the tie. Appealed claims 1, 2, 4 through 7 and 9 do not require the cable tie recited therein to have such a pocket or pocket means. The examiner has not proffered any prior art evidence to establish that the variation embodied by this difference would have been obvious to one of ordinary skill in the art.

Therefore, we shall not sustain the standing obviousness-type double patenting rejection of claims 1, 2, 4 through 7 and 9 as being unpatentable over claims 1 through 16 of the Bernard patent in view of Woods.

Finally, the application is remanded to the examiner to consider whether the disclosures of Reynolds and/or Woods justify a prior art rejection of any of the appealed claims.

For

example, both Reynolds and Woods disclose cable ties which appear to meet all of the limitations in claim 1 except arguably the one requiring "a groove formed on the embedded portion of the metal locking wedge." It is not readily apparent why this rather broad recitation of a groove is not met, or would not have been suggested, by Reynolds' disclosure of elongated opening 90 which is disposed at least in part on the embedded portion of member 86 (see Figure 7), by Reynolds' disclosure that the embedded portions of such members may be scored (see column 2, lines 38 through 41) or by Woods' disclosure of cut-outs 30, 31 which are disposed at least in part on the embedded portion of barb 25. The application is also remanded to the examiner to consider whether claims 5 and 6 are duplicates deserving of treatment in accordance with MPEP § 706.03(k).

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In summary:

a) the decision of the examiner to reject claims 1 through 9 is reversed; and

b) the application is remanded to the examiner for further consideration.

REVERSED AND REMANDED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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